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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,288	12/29/2000	John R. Stefanik	00335	8905

7590 05/03/2005

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EXAMINER

MA, JOHNNY

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/751,288

Applicant(s)

STEFANIK, JOHN R.

Examiner

Johnny Ma

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 8-22.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/31/2005 have been fully considered but they are not persuasive.

Applicant argues "there would have been no reason to combine the cited documents because the stated motivation to combine Thompson and Williams is the result of impermissible hindsight reference to Applicant's specification. However, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, it is knowledge which was within the level of ordinary skill at the time the claimed invention was made that information may be conveyed on a remote control even during times that the television display is in an off state.

Applicant argues "[s]econdly, even if one were to nonetheless combine the prompts of Williams with the system of Thompson, it is respectfully submitted that the result would not have rendered Applicant's claim 8 combination unpatentable...By way of contrast, Applicant's claim 8 combination refers to, among other things, 'a remote control device including an output device in communication with the processor, wherein the output device is for providing an alert to a user when a scheduled event occurs,' which differs from the prompts referred to by Williams." However, claim 8 recites "a transmitter in communication with the electronic

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program guide, the transmitter for transmitting data from the electronic program guide to the remote control device, wherein the data indicates an occurrence of the scheduled event." (claim 8, lines 11-13). The examiner respectfully submits that contrary to applicant's assertion, the claimed "indicates an occurrence of the scheduled event" is not equivalent to "providing an alert to a user when a scheduled event occurs." Thus, it is noted that the features upon which applicant relies (i.e., a remote control device including an output device in communication with the processor, wherein the output device is for providing an alert to a user when a scheduled event occurs) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regard to claim 16, the claimed limitation does recite "wherein the output device is for providing an alert to a user when the scheduled event occurs." Applicant argues that the reminder prompts as discussed in the Williams reference "differs from the claimed occurrence of a scheduled event. However, Applicant does not disclose the manner in which the Williams reminder prompt differs from the alert to a user when the scheduled event occurs. Furthermore, the claims are silent as to limit the "alert to a user when the scheduled event occurs" in a manner to would preclude a reminder prompt. Thus it appears that the features upon which applicant relies (i.e., alert to a user when the scheduled event occurs, a scheduled event differing from a reminder prompt) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Reminder prompts are well known in the art as scheduled events, reminder prompts are scheduled to be presented to a user at

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some point prior or at the start of the program for the purpose of reminding a user that a program of interest is currently being broadcasted. Thus the claimed providing an alert to a user when the scheduled event occurs is met by the Thompson et al. and Williams et al. combination where reminder prompt data is sent to the remote control device as discussed in the rejection of claim 8 in the previous Office Action.

In regard to claims 19-20, Applicant argues “there is no motivation for one of ordinary skill in the art to have combined these three documents in a manner to arrive at Applicant’s claim 19-20 combinations. For example, Eggen discloses providing sound effects via speaker 5 which is part of a television receiver.” The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, allowing a user to quickly identify the type of reminder notification presented as disclosed in Eggen (Eggen 2:1-3). Applicant further argues “[s]trictly arguendo, if one were to combine Eggen with the combination of Thompson and Williams, at best the result would have been the provision of sound effects at the television receiver not at the remote control device.” However, applicant’s arguments are directed against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As discussed in the previous Office Action, the combination relied upon was

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that "the examiner submits that it would have been further obvious to one of ordinary skill in the art at the time the invention was made to modify the Thompson et al. and Williams et al. remote control reminder prompts with the Eggen et al. characteristic sounds for reminders for the purpose of allowing a user to quickly identify the type of reminder notification presented (Eggen 2:1-13)" (rejection of claims 19-20). It is unclear why a modification of the Thompson et al. and Williams et al. remote control reminder prompts with the Eggen et al. characteristic sounds would result in the provision of sound effects only at the television.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (571) 272-7351. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm



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